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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/680,013 | 10/07/2003 | Michael Furst | FURST, M-2 | 4715 |

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| EXAMINER | |
|---|---|
| TRAN, THAO T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1711 | |

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/680,013 | FURST, MICHAEL | |
| | Examiner | Art Unit | |
| | Thao T. Tran | 1711 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *06 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,4-9,11-14 and 16-31* is/are pending in the application.

4a) Of the above claim(s) *27-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-9,11-14 and 16-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/6/06*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. This is in response to the Amendments filed on 02/16/2006. The IDS filed on 02/16/2006 is also acknowledged.

2. Claims 1, 4-9, 11-13, and 15-31 are currently pending in this application. Claims 2-3, 10, and 14 have been canceled. Claims 1, 11-13, and 25 have been amended.

3. Claims 27-30 have been withdrawn as directed to a non-elected invention as indicated in the Office action of 10/14/2005.

### *Claim Objections*

4. Claims 5-9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 5-9 are dependent from claim 1. However, claims 5-8 recite the polymers that are not related to polyolefin or polyacrylonitrile to further limit the subject matter in claim 1. Claim 8 recites polyacrylonitrile, which does not further limit claim 1 either.

Claim 9 is further objected to because the claim is dependent from claim 3, which has been canceled.

### *Claim Rejections - 35 USC § 112*

5. In view of the Office action of 10/04/2005, the rejections of claims 1, 4-13, 15-24, and 26 under 35 U.S.C. 112, 1st and 2nd paragraphs, have been withdrawn due to the Amendments made thereto.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-9 are indefinite due to the use of "at least one of the film layers is produced from polyamide", "at least one of the film layers is produced from polyethylene terephthalate", "the PET layer is oriented", and "at least one of the film layers is produced from polyacrylonitrile". It is unclear to the examiner what Applicants are trying to convey, because the parent claim 1 recites, "a first layer made from a polyolefin and a second film layer made from a polyolefin or a polyacrylonitrile".

Clarification on the polymers in claims 5-9 is required.

### *Double Patenting*

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 4-13, 15-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17, 22-31 of copending Application No. 10/680,012. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims of the copending application is broader than that of the instant claims, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application disclose all of the limitations as recited in the instant claims. However, the limitations recited in instant claim 1 are disclosed in claims 1-2, 25 of the copending application. Thus, the scope of claim 1 of the copending application encompasses that of instant claim 1, rendering them obvious over each other.

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. In view of the prior Office action, the rejection of claims 1, 8, 11-13, 15, and 17-26 as being anticipated by Stierli (US Pat. 4,442,148), has been withdrawn due to the Amendments made thereto.

12. Claims 1, 4-9, 11-13, 15, 17-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowe (US Pat. 4,396,665). This reference is cited in the IDS filed on 2/6/2006.

Rowe discloses a waterproofing membrane, comprising a metal foil 2 in between a polymeric film 3 and a self-adhesive bituminous composition 1 (see abstract; Figs. 1-4). The polymeric film comprises a plurality of layers of different polymers, such as polyolefin and polyethylene terephthalate (see col. 4, ln. 16-19, 34-37). The metal foil 2 is used to prevent oils present in the bituminous adhesive 1 from contacting the polymeric film 3 (see col. 5, ln. 20-24). Layers 2 and 3 are adhered to one another by a thin layer of adhesive and a removable protective sheet 4 is siliconized and applied to the bituminous adhesive (see col. 2, ln. 50-58).

With respect to how the laminate is formed, it has been well settled in the art that it is the structural elements, and not how it is made, would impart patentability when an article claim is being considered.

### *Claim Rejections - 35 USC § 103*

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. In view of the prior Office action, the rejection of claims 4-7, 9, and 16 as being unpatentable over Stierli and further in view of Bochow et al. (US Pat. 5,449,552), has been withdrawn due to the Amendments made thereto.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe as applied to claims 1 and 15 above, and further in view of Bochow.

Rowe is as set forth above and incorporated herein.

Rowe does not teach the barrier layer to be lacquer.

Bochow teaches a barrier layer of lacquer in a laminate (see col. 2, ln. 3-8). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed lacquer as the barrier layer, as taught by Bochow, in the laminate of Rowe, since it has been a common practice in the art to use lacquer or metal foil to prevent oils in the bituminous adhesive from contacting with the polymer support layer.

***Response to Arguments***

16. Applicant's arguments with respect to the rejections of the claims over Stierli and Stierli and Bochow have been considered but are moot in view of the new ground(s) of rejection.

17. The obviousness-type double patenting is maintained. Should the claims in this application and the copending application in their final forms are not obvious over each other, the obviousness-type double patenting will then be withdrawn.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
April 27, 2006

Thao Tran

THAO T. TRAN
PATENT EXAMINER